

Appl. No. 10/673,651
Docket No. 9372
Amdt. dated 11/01/06
Reply to Office Action mailed on 08/03/06
Customer No. 27752

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REMARKS

Claim Status

Claims 1-9 and 24 are pending in the present application. No additional claims fee is believed to be due.

Claim 1 has been amended to recite that the embossment sites result from the protuberances of one embossing roll engaging with the depressions of another embossing roll. Support for the amendment is found at page 10, lines 1-2 of the specification.

Claim 24 has been amended to recite that the embossment sites result from the protuberances of one embossing roll engaging with the depressions of another embossing roll. Support for the amendment is found at page 10, lines 1-2 of the specification.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Non-Statutory Obviousness-Type Double Patenting Over U.S. Pat. App. No. 10/950,706

Claims 1-9 and 24 stand provisionally rejected over Claims 1-9 and 24 of copending U.S. Patent Application No. 10/950,706 to Stelljes et al ("Stelljes") for non-statutory obviousness-type double patenting. Applicants traverse the rejection inasmuch as the Office Action states that the instant claims are not patentably distinct from those of the cited reference. However, in order to expedite prosecution of the instant Application and pursuant to M.P.E.P. §1490, Applicants enclose an appropriate terminal disclaimer compliant with 35 U.S.C. §253, 37 C.F.R. §1.321, and 36 C.F.R. §3.73. Applicants believe the above-referenced terminal disclaimer obviates the non-statutory double patenting rejection. Therefore, Applicants respectfully request reconsideration and withdrawal of the Office Action's rejection to Claims 1-9 and 24 herewith.

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Non-Statutory Obviousness-Type Double Patenting Over U.S. Pat. App. No. 11/225,946

Claims 1-9 and 24 stand provisionally rejected over Claims 1-7 of copending U.S. Patent Application No. 11/225,946 to Stelljes et al ("Stelljes") for non-statutory obviousness-type double patenting. Applicants traverse the rejection inasmuch as the Office Action states that the instant claims are not patentably distinct from those of the cited reference. However, in order to expedite prosecution of the instant Application and pursuant to M.P.E.P. §1490, Applicants enclose an appropriate terminal disclaimer compliant with 35 U.S.C. §253, 37 C.F.R. §1.321, and 36 C.F.R. §3.73. Applicants believe the above-referenced terminal disclaimer obviates the non-statutory double patenting rejection. Therefore, Applicants respectfully request reconsideration and withdrawal of the Office Action's rejection to Claims 1-9 and 24 herewith.

Declaration Under 37 CFR §132

A declaration under 37 CFR §132 is enclosed. It is the opinion of the Declarant, who is one of ordinary skill in the art, that an embossed site is distinct from a non-embossed site because an embossed site is a region that is deformed out of its original plane as a result of localized stretching, while a non-embossed site has not been deformed out of its original plane (Declaration, p. 2). Thus, the embossed sites are physically distinct and non-equivalent to the non-embossed sites and adhesive applied to an embossed site creates a different structure than one where adhesive is applied to a non-embossed site.

Rejection Under 35 USC §102(b) Over U.S. Pat. No. 3,708,366

Claims 24 has been rejected under 35 U.S.C. §102(b) over Donnelly (U.S. 3,708,366 – hereinafter "Donnelly"). In order for a prior art reference to anticipate the claims of an application, "every element and limitation of the claimed invention must be found in a single prior art referenced, arranged as in the claim." *Brown v. 3M*, 265 F.3d

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1349, 60 U.S.P.Q.2d 1375 (Fed. Cir. 2001). Applicants respectfully traverse this rejection because Donnelly does not teach every limitation claimed by the application.

Claim 24 recites, *inter alia*, an embossed multi-ply fibrous structure product comprising a first face and a second face, wherein the first face comprises non-adhesively bonded embossment sites and the second face comprises adhesively bonded non-embossed sites and that the embossment sites result from the protuberances of one embossing roll engaging with the depressions of another embossing roll.

Donnelly teaches the use of an embossing roll and a rubber roll (Donnelly, Col. 2, lines 43-46). However, Donnelly does not teach an embossment site that is formed by the protuberances of one embossing roll engaging with the depressions of another embossing roll as is claimed by Applicants. Thus, Donnelly does not teach all of Applicants' claimed limitations.

Additionally, Donnelly teaches application of adhesive to the plies in a configuration that is the opposite of what is claimed. Specifically, Donnelly teaches the application of adhesive "only in the apex portions of the embossments" (Donnelly, Col. 4, lines 23-24). However, the Office Action argues that the multi-ply product is adhesively bonded in the valleys and non-adhesively bonded at the peaks, and that the structure could simply be inverted so that the peaks are the valleys and vice versa, thus making it only a matter of semantics whether one refers to something as an embossment or a non-embossment. (Office Action dated August 3, 2006, p. 8). Applicants respectfully disagree with the Office Action's assessment. The embossed areas are structurally unique from the non-embossed areas as is made clear by the enclosed declaration. Further, Donnelly discloses that embossments are physically distinct from unembossed areas by stating that "embossments are projections from the surface of the web 6 and are effected generally by localized stretching of the web between the rolls and on the protuberances of the rolls." (Donnelly, col. 3, lines 32-35). In other words, the unembossed areas are physically and structurally distinct from the embossed areas and it is not a mere semantic argument of what is an embossed area and what is a non-embossed area. Similarly, Donnelly does not teach a first face comprising non-adhesively bonded

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embossed sites. As stated above, Donnelly, referring to Figs. 2 and 3, discloses that the adhesive is present only in the "apex portion of the embossments" (Donnelly, Col. 4, line 23-24), or that the adhesive is only present in the uppermost point of the embossments. Thus, it is the structurally distinct embossments, and not the non-embossed areas, that have adhesive and Donnelly fails to teach every limitation as is claimed by Applicants.

The Office Action also argues that Donnelly teaches non-adhesively bonded emboss sites (Office Action dated August 3, 2006, p. 4), but the example that the Office Action cites (Donnelly, Col. 3, line 70 through Col. 4, line 2) does not teach the use of adhesive in the non-embossed sites as is claimed by Applicants. Specifically, Donnelly only discloses that the pressure from embossing "should be sufficient to unite the webs either with the aid of the adhesive or in the absence of it", but this fails to teach a first face comprising non-adhesively bonded embossed sites as is claimed by Applicants.

Because Donnelly does not teach every element as is claimed by Applicants, Applicants respectfully request that the Office Action's rejection to Claim 24 under 35 U.S.C. §102(b) be withdrawn.

Rejection under 35 U.S.C. 103(a) over U.S. Pat. No. 3,708,366
in view of U.S. Pat. No. 5,846,636

Claims 1-9 have been rejected under 35 U.S.C. §103(a) over Donnelly in view of (U.S. 5,846,636 – hereinafter "Ruppel"). Applicants respectfully traverse this rejection because a *prima facie* obviousness has not been met. *In re Harris*, 409 F.3d 1339 (Fed. Cir. 2005). Further, Donnelly in view of Ruppel teaches away from the claimed invention. *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006); MPEP §2145. In finding that a claimed invention is not obvious in view of the prior art, it is well settled that "a prior art reference must be considered in its entirety ... including portions that would lead away from the claimed invention." MPEP §2141.02.

Applicants' independent Claim 1 recites, *inter alia*, an embossed multi-ply fibrous structure product comprising a bond area of less than about 30% of the bonded adjacent surfaces, non-adhesively bonded embossment sites, adhesively bonded non-

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embossed sites wherein the embossment heights are at least about 1000 microns and that the embossment sites result from the protuberances of one embossing roll engaging with the depressions of another embossing roll.

As argued above, Donnelly neither teaches that the embossment sites are formed from the protuberances of one embossing roll engaging with the depressions of another embossing roll nor does Donnelly teach non-adhesively bonded embossment sites. Ruppel fails to rectify the deficiencies of Donnelly as Ruppel also **teaches the use of an embossing roll and a rubber roll** (Ruppel, Col. 3, lines 36-43) and the **application of adhesive on the embossed areas** ("protrusions") (Ruppel, Col. 3, lines 52-55), thus failing to teach, suggest, or motivate Applicant's claimed limitations. Further, by teaching that only the embossment sites contain adhesive (Donnelly, Col. 4, lines 22-36; Ruppel, Col. 3, lines 52-55), Donnelly and Ruppel provide no motivation, teaching, or suggestion to apply adhesive to the non-embossed sites (as claimed by Applicants). Thus, Donnelly in view of Ruppel do not make obvious Applicants' claimed invention.

Further, Applicants submit that the physical limitations claimed in Claims 1, 2, 3, and 6 (less than 30% adhesive, plybond strength of at least about 4 g/in, wet burst of at least about 305 g, and CD stretch at peak load of greater than 8%, respectively) are not explicitly taught by either Donnelly or Ruppel. The Office Action argues that such would have been obvious to one of ordinary skill in the art who would be making an improved paper product. (Office Action dated August 3, 2006, p. 6-7). Applicants assert that unless the Office Action has provided an actual teaching, suggestion, or motivation, a mere reference to "skill in the art" is not sufficient basis to combine or modify references under §103 obviousness standards. In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998).

Applicants respectfully requests that the Office Action's rejection to Claims 1-9 under 35 U.S.C. §103(a) be withdrawn because the combination of Donnelly in view of Ruppel does not teach, disclose, or suggest Applicants' claimed invention.

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Conclusion


In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. §102(b) and 35 U.S.C. §103(a). Early and favorable action in the case is respectfully requested.

This response represents an earnest effort to place the application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1-9 and 24 is respectfully requested.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By


Peter T. Nguyen
Registration No. 58,282
(513) 634-4268

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Customer No. 27752